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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/922,425	08/03/2001	Gary Mittman	R258-DB	7477

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EXAMINER

RETTA, YEHDEGA

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 02/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/922,425	MITTMAN ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Yehdega Retta	3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 09 December 2002.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-8 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)           | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ .                                   |

## **DETAILED ACTION**

### ***Response to Amendment***

1. This office action is response to the communication filed Dec. 09, 2002.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1-8 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-8 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude. The claimed invention as a whole may not be adequately described if the claims require an essential or critical feature which is not adequately described in the specification and which is not conventional in the art or known to one of ordinary skill in the art. The independently claimed steps of means for tracking the timing of Internet-related goals achieved by said Internet user related to his accessing said Internet website address (which is included in the media purchase), when the advertising media purchase includes the unique trackable

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identifier, such as a code, for accessing further information related to the subject matter of the media purchase and correlating and reporting the timing of Internet-related goals to the media purchase is a critical feature which is not adequately described in the specification and which is not conventional in the art or known to one of ordinary skill in the art, because the specification does not teach how the user accesses an Internet website address when a unique trackable identifier is provided, with the media purchase, to the user. How does the user access further information related to the subject matter by referring to the unique identifier? The system does not include "means for" when a unique trackable identifier is used instead of Internet website address. There is no correlation between the unique identifier included in the media purchase and the web site address being tracked for Internet-related goals. Since claims 2-8 are dependent upon the essential or critical feature, those claims are also rejected as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s) had possession of the claimed invention. In light of the specification, as best understood by the examiner the rejection of 102 or 103 as stated below applies.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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5. Claim 1, recites limitation in an alternative way. The claim recites the [advertising] media purchase including either an Internet website address or a unique trackable identifier. Applicant in his argument explains the unique identifier such as a code number used in a special purchase offer being provided, however the claimed database does not include data related to goals or activities achieved during the promotional period. There is no correlation between the code or identifier provided with the purchase media and the Internet related goals achieved by an Internet user related to accessing Internet website address. By claiming a unique trackable identifier included in a purchase media and tracking timing of Internet-related goals makes the claim indefinite.

6. Claims 2-8 are rejected since they depend on rejected claim.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Branddata(TM) as stated in the articles "Promotion Insights tracks coupons used in web" by Liz Parks (hereinafter Parks), "International Data L.L.C launches on-line redemption database" and "<http://web.archive.org/web/200001190811...nddata.com/intdata/docs/branddata2a>" (hereinafter web.archive.org) and further in view of Ryu U.S. Patent No. 6,377,961.

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9. Regarding claims 1-8, Branddata teaches tracking advertising media purchase relating to a predetermined subject matter and being placed in either movies, video,...within a stated geographical area, said media purchase including unique trackable identifier (barcode) (see page 1 of web.archive.org), database containing records relating to the start date, end date and stated geographical area for a plurality of media purchases and means for inputting and maintaining records in a first database (see page 1 of Parks). Branddata does not teach determining the geographical location associated with an Internet Protocol address, means for grouping said geographic locations into uniform stated geographic area and a second database containing records correlating Internet protocol addresses of Internet users with stated geographic area and means for inputting and maintaining records in the second database, it is disclosed in Ryu (see col. 4 lines 29-55). Ryu teaches a database correlating Internet address and geographical address. It would have obvious to one of ordinary skill in the art at the time of the invention to combine Branddata's tracking of distributed coupon and Ryu's Internet address and geographical address database in order to allow the distributors of the coupon to access the server that tracks the distributed coupons. Since the claimed invention is claimed in an alternative way, and if the media purchase includes a unique trackable identifier, the limitation related to the media purchase including an Internet website address does not apply. Therefore, no weight was given to limitations, such as determining the Internet Protocol address of an Internet user accessing said Internet website address, tracking the timing of Internet-related goals by said user related to his accessing said Internet website address.

10. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walter et al. U.S. Patent No. 6,334,110 further in view of Official Notice.

11. Regarding claims 1-8, Walter teaches advertising media purchase being placed in either of movies, video, television, interactive television, radio or print media within geographic area; a first database containing records relating to the start date, end date and stated geographic area for a plurality of media purchase and means for inputting and maintaining the records (see fig. 7, 8 &9 and col. 6 line 47 to col. 7 line 36); means for grouping said geographic locations into uniform stated geographic area; means for tracking the timing of the Internet-related goals achieved by Internet user of an Internet website address and means for correlating and reporting the timing of the Internet-related goals achieved by the Internet user with the start date...media purchase effectiveness report...complied continuously from the start date...(see fig 7-11 and col. 7 lines 10-36). Walter teaches tracking user behaviors at any time therefore, it would be obvious to correlate and report Internet-related goals achieved with residual period since any Internet user who saw the advertisement the last day of the ad, would purchase a product related to the media purchase few days later. Walter teaches the region (geographic location) where the advertisement (campaign) is to run and the analysis of the campaign based on different regions (see fig. 11). Walter does not explicitly teach means for determining the geographic location associated with an Internet Protocol address and determining the Internet Protocol address of an Internet user accessing the Internet website address. Official notice is taken that determining the Internet Protocol address of an Internet user accessing a website and determining the geographic location associated with the Internet Protocol address and is old and well known in the art of Internet and also as admitted art by the applicant. It would have been obvious to one of ordinary skill in the art at the time of the invention to determine the Internet Protocol address of the Internet user accessing a website and determining the geographic location in order to provide

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target advertisement or promotional campaign to specific audiences. Walter teaches the mode the campaign is to be distributed (in store coupon, home mailer, etc), however Walter does not explicitly teach an Internet website address being included in the media purchase. Official notice is taken that is old and well known to include addresses or location of a business site, the campaign is being run for, in the art of marketing. It would have been obvious to one of ordinary skill in the art at the time of the invention to include the address of the business site, whether it is an Internet address or brick and mortal stores, in order to inform potential buyer the location of the business site.

### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Koeppel et al. U.S. Patent No. 6,477,575 teaches performing dynamic web marketing and advertising.

Blumenau U.S. Patent No. 6,434,614 teaches tracking of Internet advertisement using banner tags.

Weinblatt U.S. Patent No. 5,515,270 teaches correlating purchasing behavior of a consumer to advertisements.

D'Eon et al. U.S. Patent No. 6,006,197 for assessing effectiveness of Internet Marketing campaign.

Benson U.S. Patent No. 6,470,079 teaches real-time reporting of advertising effectiveness.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (703) 305-0436. The examiner can normally be reached on 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (703) 305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9326 for regular communications and (703) 872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

  
Yehdega Retta  
Examiner  
Art Unit 3622

YR

February 21, 2003